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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,480	03/29/2004	Nicholas M. Valiante JR.	20426.003	9427

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EXAMINER

CHONG, YONG SOO

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,480

Applicant(s)

VALIANTE, NICHOLAS M.

Examiner

Yong S. Chong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 24, 26, 30 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 24, 26, 30 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's response filed on 8/22/2005. Claims 21, 24, 26, 30, 36-39 are pending. Claims 1-20, 22-23, 25, 27-29, 31-35 have been cancelled. Claims 21, 24, 26, 30 have been amended. Claims 36-39 are new. Election was made **without** traverse in the reply filed on 8/22/2005. The requirement is deemed proper and is therefore made FINAL. Claims 21, 24, 26, 30, 36-39 are examined herein.

Applicant's request that claims 26, 36-39 be added to the claim set is granted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 21, 24, 26, 30, 36-39 are rejected under 35 U.S.C. 103(a) as being obvious over Renhowe et al. (US 2004/0087626 A1) in view of Klaviniskis et al. (US 2003/0147923 A1).

The instant claims are directed to a composition comprising a SMIP compound of formula XXI and an antigen.

Renhowe et al. teach substituted benzazoles of formula I to treat cancer (abstract), for example N-methyl-4-({1-methyl-2-[6-pyrrolidin-1-ylpyridin-3-yl]amino}-1H-benzimidazol-5-yl}oxy)pyridine-2-carboxamide (pg. 83, example 365). Renhowe et al. further teach that the composition containing compounds of formula I can also contain biological response modifiers (section 0071), pharmaceutically acceptable carriers, and adjuvants (section 0131).

Renhowe et al., however fail to disclose specifically the MF59 adjuvant and antigens associated with influenza, haemagglutinin and neuraminidase surface protein in the composition.

Klaviniskis et al. teach that antigens can be used as adjuvants in the present composition (pg. 15, section 0155) to boost an immune response in a mammal (abstract). In addition to the MF59 adjuvant (pg. 2, section 0014), other antigens that are mentioned to be useful are influenza, hemagglutinin, and neuraminidase (pg. 14, section 0147).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to combine the adjuvants as taught by Klaviniskis et al. with the composition as taught by Renhowe et al.

A person of ordinary skill in the art would have been motivated to make this combination because of the expectancy to stimulate and enhance the immune response with the adjuvants taught by Klaviniskis et al. (abstract) of cancer patients being treated with compounds of formula I as taught by Renhowe et al.

Examiner respectfully points out that the intended use of claim 26, directed to the biological function of the composition is given no patentable weight.

It is well known in Patent Law that if applicants are claiming a biological pathway as the basis for their invention then a mechanism by which the active ingredient gives the pharmacological effect does not alter the fact that the compound has been previously used to obtain the same pharmacological effects which would result from the claimed method. The patient, condition to be treated, and the effect are the same. An explanation of why that effect occurs does not make novel or even unobvious the treatment of the conditions encompasses by the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

Sheng Xun Wang
SHENG XUN WANG
PRIMARY EXAMINER